68

No. 07-122

FILED
SEP 21 2007
OFFICE OF THE CLERK
SUPREME COURT, U.S.

In The

Supreme Court of the United States

JEFFREY A. GRUSENMEYER & ASSOCIATES, INC.,
Petitioner,

v.

DAVISON, SMITH & CERTO ARCHITECTS, INC.,
WILLIAM R. DAVISON
RANDALL S. SMITH
JEFFREY M. CERTO,
Respondents.

On Petition for a Writ of Certiorari to the United States Court of Appeals for the Sixth Circuit

PETITIONER'S REPLY BRIEF

JON A. TROYER
On the Brief
1953 GULF ST., NW
UNIONTOWN, OH 44685
(330) 564-3431

BRUCE H. WILSON
Counsel of Record
789 WEST MARKET ST.
AKRON, OH 44303
(330) 253-8300

Counsel for Petitioner

Becker Gallagher · Cincinnati, OH · Washington, D.C. · 800.890.5001

QUESTIONS PRESENTED FOR REVIEW

Whether architectural drawings of existing conditions should be denied copyright protection as a categorical rule.

Whether the phrase in an architect's contract that says he would prepare "plans, renderings, and perspectives suitable for use in presentation and future reference" by his client, should be construed by a court to permit a competing architect to copy, adapt, distribute, and display those works as its own without considering the effect of the Copyright Act of 1976 on the contract language.

CORPORATE DISCLOSURE STATEMENT

Petitioner Jeffrey A. Grusenmeyer & Associates, Inc. has no parent corporation, and no publicly held corporation owns more than 10% of its stock.

TABLE OF CONTENTS

QUESTIONS PRESENTED FOR REVIEW i

CORPORATE DISCLOSURE STATEMENT ii

TABLE OF AUTHORITIES iv

REPLY TO BRIEF IN OPPOSITION 1

I. The Sixth Circuit Fully Considered the Copyright Issues Presented in the Petition for Certiorari 1

II. Respondents Admitted to Verbatim Copying 4

III. Grusenmeyer Did Not Copy Drawings of Existing Conditions Made By Others 5

IV. AIA Provisions Were Part of the Contract 6

V. The Petition Rests on Purely Legal Grounds 7

VI. Contrary to Respondents' Assertions, Petitioner's Arguments are Not Concocted, Specious, Artificial, Meritless, Nefarious, Hyperbolic, or Mere Sophistry . 8

CONCLUSION 9

TABLE OF AUTHORITIES

Cases

ATC Distrib. Group, Inc. v. Whatever It Takes Transmissions & Parts, Inc., 402 F.3d 700 (6th Cir. 2005) 8

Blanchard Valley Farmers Cooperative, Inc. v. Rossman, 761 N.E.2d 1156 (Ohio App. 2001) 6

Christe v. GMS Mgt. Co., 705 N.E.2d 691 (Ohio App. 1997) 6

Inland Bulk Transfer Co. v. Cummins Engine Co., 332 F.3d 1007 (6th Cir. 2003) 6

Johnson v. Jones, 149 F.3d 494 (6th Cir. 1998) 7

Lyrick Studios, Inc. v. Big Idea Productions, Inc., 420 F.3d 388 (5th Cir. 2005) 3

Meshwerks, Inc. v. Toyota Motor Sales U.S.A., Inc., 2006 WL 2623935 (D. Utah 2006) 8

Ritchie v. Williams, 395 F.3d 283 (6th Cir. 2005) 2

Sparaco v. Lawler, Matusky & Skelly Engineers LLP, 303 F.3d 460 (2nd Cir. 2002) 1, 4, 8

Television Espanola S.A. v. New World Entertainment, Ltd., 183 F.3d 922 (9th Cir. 1999) 3

Statutes and Rules

17 U.S.C. § 101 . . . . . 6, 7

17 U.S.C. § 102 7

17 U.S.C. § 106 . . . . . 3, 7

17 U.S.C. § 202 . . . . . 2, 7

17 U.S.C. § 204 . . . . . 3, 7

17 U.S.C. § 301 . . . . . 2, 3, 7

Supreme Court Rule 15.6 1

Other Authorities

18 Ohio Jurisprudence 3d, *Contracts*, §§ 152, 157 (1980) 6

Melville B. Nimmer and David Nimmer, 3-10 *Nimmer on Copyright*, § 10.03 (2007) 3

REPLY TO BRIEF IN OPPOSITION

Jeffrey A. Grusenmeyer & Associates, Inc. ("Petitioner") petitioned the Court for a writ of certiorari to review the judgment of the United States Court of Appeals for the Sixth Circuit entered in this case, in order to resolve a conflict between the Sixth Circuit, which now holds that architectural drawings of existing conditions are not eligible for copyright protection, and the Second Circuit's decision in *Sparaco v. Lawler, Matusky & Skelly Engineers LLP*, 303 F.3d 460 (2nd Cir. 2002) which holds that a site plan depicting existing conditions can be copyrightable. The petition also seeks review of the degree of deference courts must show the Copyright Act of 1976 in state law contract interpretation.

Pursuant to Supreme Court Rule 15.6, Petitioner herein replies to assertions made in Respondents' Brief in Opposition.

I. The Sixth Circuit Fully Considered the Copyright Issues Presented in the Petition for Certiorari

Respondents assert that the Sixth Circuit never addressed the issue of whether Petitioner's drawings were or were not subject to copyright protection. (Respondents' Brief in Opposition, at 13) (hereinafter "Opp."). Respondents further assert that the copyright issue in this case was decided by the District Court, and not by the Sixth Circuit. (Opp. at 14). Contrary to Respondents' assertions, Grusenmeyer raised this issue on appeal before the Sixth Circuit, and again in the Petition for Rehearing, wherein he stated, "Grusenmeyer has not abandoned his appeal of the district court's opinion regarding his copyright. Left unresolved by the Court, Grusenmeyer may have no recourse against any future infringement of his registered work by others...." (Petition for Rehearing, at 12). The Sixth Circuit denied the rehearing

because, "the issues raised in the petition were *fully considered upon the original submission* and decision of the case." (Petition for Writ of Certiorari Appendix, at 4a) (hereinafter "Pet. App.") (emphasis added).

Respondents also assert that Grusenmeyer's preemption argument was never made in the courts below and that "this Court does not consider issues that are raised for the first time in the petition for certiorari." (Opp. at 16). The preemption argument in support of Grusenmeyer's position is that the contract between Grusenmeyer and Magnificat can not be interpreted in the manner it was, if the courts below had applied the limitations of the Copyright Act.

Contrary to Respondents' assertion, Grusenmeyer cited to *Ritchie v. Williams*, 395 F.3d 283 (6th Cir. 2005), and 17 U.S.C. § 301(a) in arguing to the Sixth Circuit the importance of complete federal preemption in interpretation of contracts involving copyrightable subject matter. The following excerpt is from Grusenmeyer's Petition for Rehearing:

> The Copyright Act of 1976 preempts state law and controls contract claims involving copyrightable subject matter. *Ritchie*, 395 F.3d at 286-288; 17 U.S.C. § 301(a). The contract was intended to *protect* Grusenmeyer's copyrights, not give them away. Payment for the extensive 'master planning services' and the subsequently delivered printed copies of the Master Plan, only entitled Magnificat to ownership of those particular printed copies, and use of the *factual information* contained therein—no more. 17 U.S.C. § 202 (transfer of the material object does not convey any rights in the copyrighted work embodied in the object). The contract between Grusenmeyer and Magnificat only transferred

ownership to Magnificat of the printed hard copies of the Master Plan.

Even if the district court and the panel *assume* that the infringed electronic AutoCAD® drawings were obligated under the contract, the contract did not transfer ownership of Grusenmeyer's copyrights in them. 17 U.S.C. § 204(a) (requiring any transfer of rights to be in writing). "'No magic words must be included in a document to satisfy § 204(a).' It must, however, show *an agreement to transfer copyright*." *Lyrick Studios, Inc. v. Big Idea Productions, Inc.*, 420 F.3d 388, 392 (5th Cir. 2005) (emphasis added), *citing Television Espanola S.A. v. New World Entertainment, Ltd.*, 183 F.3d 922, 927 (9th Cir. 1999). "Transfer of the physical object does not transfer statutory copyright. To the extent that a writing is ambiguous as to whether it refers to copyright or physical interest, it could fail to transfer copyright ownership." 3-10 *Nimmer on Copyright* § 10.03 [A][3].

The right of display is distinct from the right of reproduction. 17 U.S.C. § 106. Granting permission to 'present' does not grant a license to copy, adapt, or distribute. Granting permission to 'refer to' does not grant a license to copy, adapt, distribute, or display. The only one of the exclusive rights of copyright that Magnificat may have received a license to, is that of 'display.' However, even then, such display would have to be of Grusenmeyer's work, not of someone else's infringing adaptation or copy of that work. The panel's opinion therefore, sharply restricts the scope of the Copyright Act's authority that Congress conferred in 17 U.S.C. § 301.

(Petition for Rehearing, at 10-11). To repeat, the Sixth Circuit denied the rehearing because, "the issues raised in the petition were *fully considered* upon the original submission and decision of the case." (Pet. App. at 4a) (emphasis added).

By affirming the district court, the Sixth Circuit adopted its reasoning that architectural drawings of existing conditions are not copyrightable as a matter of law. (Pet. App. at 23a) ("Like the site plan in *Sparaco*, Plaintiff's drawings set forth the existing physical characteristics of the facilities at Magnificat and, as such, they set forth facts."). As a consequence, Grusenmeyer now has no recourse against any future infringement of his registered work by others. The categorical rule that architectural drawings of existing conditions are mere facts, and not copyrightable, will imperil the exclusive rights expressly afforded by Congress in the Copyright Act of 1976.

II. Respondents Admitted to Verbatim Copying

Respondents state in their Brief in Opposition that, "DS&C has admitted only that it received a disk from Magnificat that exclusively contained existing conditions." (Opp. at 7). Instead, in their Brief in Opposition to Plaintiff's Motion for Summary Judgment, the Respondents stated the following:

> Defendants admit that they obtained a copy of Plaintiffs drawing of existing conditions from Magnificat High School ("Magnificat") in AutoCAD format. Defendants admit incorporating the existing conditions in some drawings of the Magnificat Performing Arts Center. Defendants admit that Plaintiff obtained copyrights for his drawings which

> included existing conditions. ...These admissions do not render Plaintiff's work original....

(R.34-1, Defendants' Opposition to Plaintiff's Motion for SJ, at 2). Respondents stated further, "these facts relevant to Plaintiff's Motion for Summary Judgment are not in dispute." (Id.).

Respondent Certo testified in deposition to the extensive copying of Grusenmeyer's work, including drawings bearing the DS&C architectural seal that were instead entirely authored by Grusenmeyer. (R.31-2, Certo Depo., at 23-25); (R.38, Certo Depo., Exhibit 6). Grusenmeyer asserted in his Reply Brief before the Sixth Circuit that at least 31 drawings bearing the DS&C architectural seal contained his work, including eight that were 100% verbatim copies of his drawings. (Reply Brief of Appellant Jeffrey A. Grusenmeyer & Associates, Inc., at 12). Those assertions remain unrebutted by the Respondents.

III. Grusenmeyer Did Not Copy Drawings of Existing Conditions Made By Others

Respondents state that Grusenmeyer "utilized" existing drawings, including some that had been prepared by DS&C in connection with earlier renovations. (Opp. at 5). Respondents later state that DS&C "confirmed and then utilized, if confirmed, the drawings of the existing conditions...." (Opp. at 7). However, Grusenmeyer was careful not to do what Respondents did in this case. Any use of preexisting material by Grusenmeyer was limited to extracting *factual information*, such as dimensions and elevations. (Pet. App. at 31a-34a). Grusenmeyer then created his own original expression of the campus of Magnificat. (Id.).

Respondents further assert that DS&C's conduct "was done as part of the protocol of the industry." (Opp. at 7). If this is, or was to become, the industry protocol, it is all the more reason for this Court to grant *certiorari* in this case. Indeed, the law of copyright forbids such copying, and those who do engage in it thwart the Congressional intent to preserve the copyrights of those who don't.

IV. AIA Provisions Were Part of the Contract

Respondents state that Grusenmeyer never provided Magnificat with the AIA Document B151: Abbreviated Form of Agreement Between Owner and Architect, 1987 Edition. (Opp. at 3). Respondents assert that the two-page letter agreement between Grusenmeyer and Magnificat was, "a writing separate and apart from the AIA Abbreviated Form Agreement." (Opp. at 19). However, "[w]hen documents are incorporated by reference into a document, they are to be read as though they are restated in the contract." *Inland Bulk Transfer Co. v. Cummins Engine Co.*, 332 F.3d 1007, 1016 (6th Cir. 2003), citing *Blanchard Valley Farmers Cooperative, Inc. v. Rossman*, 761 N.E.2d 1156, 1162 (Ohio App. 2001). The district court recognized as much when it noted in its decision that the AIA Document was incorporated in the contract. (Pet. App. at 27a, fn. 3). The Sixth Circuit did not reverse this finding.

"Where one instrument incorporates another by reference, both must be read together. 18 Ohio Jurisprudence 3d (1980), *Contracts*, § 152. Courts should attempt to harmonize provisions and words so that every word is given effect. *Id.*, § 157." *Christe v. GMS Mgt. Co.*, 705 N.E.2d 691, 693 (Ohio App. 1997). Since the AIA document and the two-page letter agreement are part of the same contract, the two-page letter agreement can not be the separate agreement

with "additional compensation" required by AIA Article 6.1, as previously interpreted by the Sixth Circuit in *Johnson v. Jones*. 149 F.3d 494, 500 (6th Cir. 1998).

V. The Petition Rests on Purely Legal Grounds

Respondents assert that, "there is no reason for this Court to review such a fact-specific decision...." (Opp. at 14). However, the facts of this case describe the widespread use of the American Institute of Architects Standard Forms of Agreement, which would now seem to command little respect. If the Court of Appeals decision has persuasive effect, there will be those who may want to ignore the copyright protection provisions of the AIA forms when it suits them to do so.

Further, this was a summary judgment disposition at the district court, based on material facts not in dispute. The Petition for Writ of Certiorari rests purely on legal principles—principles such as those found in 17 U.S.C. § 101, which defines "pictorial, graphic, and sculptural works" (expressly granted copyright protection in § 102(a)(5)), to include technical drawings, which encompasses architectural plans; and 17 U.S.C. § 106, which defines the exclusive rights protected by copyright, so that granting a right to display does not mean that any other right has been so granted; and 17 U.S.C. § 202, which states that ownership of any material object in which the work is embodied is not the same as ownership of the copyright, or of any of the exclusive rights under a copyright; and 17 U.S.C. § 204, which requires that any transfer in copyright ownership must be evidenced by a signed writing indicating the transfer; and 17 U.S.C § 301, which makes clear that the Copyright Act preempts any state law claim involving the subject matter of copyright as specified by § 102.

VI. Contrary to Respondents' Assertions, Petitioner's Arguments are Not Concocted, Specious, Artificial, Meritless, Nefarious, Hyperbolic, or Mere Sophistry

Respondents assert that "resolution of the [circuit] conflict would not alter the Sixth Circuit's affirmance of the District Court's summary judgment on the dispositive contract issue." (Opp. at 10). However, this Court of Appeals decision has implications beyond the parties to the current litigation.

Already, another circuit is being urged to accept the Sixth Circuit's adopted rule, regarding architectural drawings of existing conditions, to invalidate copyrights for other drawings of a technical nature. See *Meshwerks, Inc. v. Toyota Motor Sales U.S.A., Inc.*, 2006 WL 2623935 at *3 (D. Utah 2006) (district court decision).[1] Respondents' ridicule of this case as "an exceptionally poor vehicle to resolve any question presented" (Opp. at 20), does not inform the reader—and although annoying, it cannot obscure the question as to whether the persuasive effect that the Sixth Circuit opinion could have on other circuits is reason enough to grant the writ.

Respondents state that, "[t]he disk provided to DS&C did not have any of Grusenmeyer's original ideas; it was all

---

[1] The case is currently before the Tenth Circuit Court of Appeals, Case No. 06-4222, and is scheduled for oral argument in November, 2007. In briefing, the Appellees have cited to the district court decision in *Grusenmeyer* (noting the Sixth Circuit's affirmance), *ATC Distrib. Group, Inc. v. Whatever It Takes Transmissions & Parts, Inc.*, 402 F.3d 700 (6th Cir. 2005), and *ATC's* version of the *Sparaco* decision (despite the *Sparaco* decision's holding to the contrary), in support of the district court's judgment denying copyright to digitized models of Toyota automobiles.

existing conditions." (Opp. at 6-7) (emphasis added). The Sixth Circuit's Opinion states that, according to the individual DS&C architects, verbatim copying "is accepted practice ...without first seeking permission where the drawings utilized merely document *existing conditions*." (Pet. App. at 9a) (emphasis added). The Sixth Circuit apparently agreed with the DS&C individual architects' dogmatic insistence that, as a category, architectural drawings of existing conditions are undeserving of copyright protection. Respondents' contract argument is pretextual, with the ultimate issue in this case being the copyrightability of architectural drawings of existing conditions.

CONCLUSION

Along with the reasons asserted in the Petition for Writ of Certiorari, for all the foregoing additional reasons, the petition should be granted.

Respectfully submitted,

BRUCE H. WILSON
Counsel of Record
789 WEST MARKET ST.
AKRON, OHIO 44303
(330) 253-8300

Counsel for Petitioner